

REMARKS

Claims 74-79 currently appear in this application. The Office Action of March 27, 2003, has been carefully studied. These claims define novel and unobvious subject matter under Sections 102 and 103 of 35 U.S.C., and therefore should be allowed. Applicants respectfully request favorable reconsideration, entry of the present amendment, and formal allowance of the claims.

All of the claims have been rejected under 35 U.S.C. 103(a) as being unpatentable over Oellerking in view of Weber.

This rejection is respectfully traversed. Claims 53-59, 61-67 and 70-73 have been cancelled and replaced by new claims 74-79. Claims 74-79 limit the material to a configuration in which the welding portion extends across part of the width of the welding fabric, wherein the welding portion is at each end of the welding fabric, or wherein the welding portion is in the middle portion of the fabric. None of these configurations is disclosed or suggested by either Oellerking or Weber, since in both Oellerking and Weber the welding portion is located where it is for a specific purpose.

Oellerking places the welding portion around the periphery of the patch in order to detect any

tampering with the patch. The welding portion (*i.e.*, adhesive) is across the entire bottom surface of the patch in Weber so as to impart strength to the tarpaulin.

If the welding portion were to extend across part of the width of the welding fabric, or to be located at each end of the welding fabric, or to extend across part of the width of the welding fabric, there would be places on the material which there was no welding of the material to the substrate, and it would be possible to lift up part of the patch to tamper with the patch, and this tampering would not be detected.

Weber provides the adhesive and patch to impart additional strength to a tarpaulin. There is no motivation for Weber to adhere the patch with less adhesive than across the entire patch, because to do so would compromise the additional strength the patch is designed to impart to the tarpaulin.

Claims 53-59, 61-67, and 70-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber in view of Oellerking.

This rejection is respectfully traversed. As noted above, Weber applies a patch to a tarpaulin to increase the strength of the tarpaulin. Using less adhesive than is necessary to adhere the entire surface of the patch to the tarpaulin would not provide the

desired effect, namely, increasing the strength of the tarpaulin. This can only be accomplished by ensuring that the entire surface of the patch is adhered to the tarpaulin. Oellerking applies a patch using adhesive around the periphery of the patch so that any tampering, *i.e.*, lifting the patch, can be detected. There is no reason in any combination of Oellerking and Weber to use a welding portion over a middle portion of a fabric, at both ends of a fabric, or which extends over part of the width of the welding fabric.

As the Federal Circuit stated in *In re Lee*, 61 USPQ2d 1430 (January 18, 2002, Fed. Cir.), "As applied to the determination of patentability *vel non*, when the issue is obviousness, 'it is fundamental that rejections under 35 U.S.C. 103 must be based on evidence comprehended by the language of that section.' *In re Grasselli*, 53 USPQ2d 1769, 1774 (Fed. Cir. 2000)... When patentability turns on the question of obviousness, the search for an analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, *e.g.*, *McGinley v. Franklin Sports, Inc.*, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ('the central question is whether

there is a reason to combine [the] references,' a question of fact drawing on the *Graham* factors."

'The factual inquiry whether to combine references must be thorough and searching.' *Id.* This precedent has been reinforced in myriad decisions, and cannot be dispensed with, *See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000). ('a showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential component of an obviousness holding"'') (quoting *C. R. Bard, Inc. v. M3 Systems, Inc.* 48 USPQ2d (Fed. Cir. 1998)) The Court went on to quote *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."

There is a requirement for specificity in combining references, *See, In re Kotzab*, 55 USPQ2d 13134, 1317 (Fed. Cir. 2002) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.").

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In the present case, the Examiner has shown no motivation to combine Weber and Oellerking, or Oellerking and Weber, to arrive at the particular invention claimed herein.

In view of the above, it is respectfully submitted that the claims are now in condition for allowance, and favorable action thereon is earnestly solicited.

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